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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/790,488	03/01/2004	Matthew L. Sherman	AM-101314USA	9527
38199 7590 08/09/2007 HOWSON AND HOWSON/WYETH CATHY A. KODROFF SUITE 210 501 OFFICE CENTER DRIVE FT WASHINGTON, PA 19034			EXAMINER BETTON, TIMOTHY E	
			ART UNIT 1614	PAPER NUMBER
			MAIL DATE 08/09/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.

10/790,488

Applicant(s)

SHERMAN ET AL.

Examiner

Timothy E. Betton

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 17 July 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-48 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-48 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>See Continuation Sheet</u>                                    | 6) <input type="checkbox"/> Other: _____                          |

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :7 sheets,  
01October2004, 02June2004.

### **DETAILED ACTION**

Applicant's election of the subject matter in Group I, claims 1-44 and the species election of an aromatase inhibitor, letrozole election in the reply filed on 17 July 2007 is acknowledged.

The Examiner made the inadvertent grouping of method with composition claims as being drawn solely to CCI-779 and an aromatase inhibitor. In view of this, the restriction requirement has been withdrawn. Claims 1-48 will be examined together. The method claims will be examined together with the composition claims. Accordingly, the claim(s) directed toward the rapamycin compound will be examined together with the claim(s) directed toward CCI-779.

Applicant's request for clarification has been noted. It was an inadvertent omission in the restriction requirement that the group was set forth as being drawn solely to CCI-779 and an aromatase inhibitor. Accordingly, the claim(s) directed toward the rapamycin compound will be examined together with the claim(s) directed toward CCI-779.

### ***Status of the claims***

Claims 1-48 are pending. Claims. Claims 1-48 are under examination.

### ***Claim Rejection- 35 USC §112, 1<sup>st</sup> paragraph***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the

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art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-5, 7-34, and 36-48 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the treatment of breast cancer using the claimed combinations, does not reasonably provide enablement for treatment of all neoplasms of any type. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make/use the invention commensurate in scope with these claims.

Factors to be considered in determining whether a disclosure would require undue experimentation have been summarized in *Exparte Forman*, 230 USPQ 546 (BPAI 1986) and reiterated by the Court of Appeals in *In re Wands*, 8 USPQ2d 1400 at 1404 (CAFC 1988). The factors to be considered in determining whether undue experimentation is required include:

- 1) the quantity of experimentation necessary
- 2) the amount of direction or guidance provided
- 3) the presence or absence of working examples
- 4) the nature of the invention
- 5) the state of the art
- 6) the relative skill of those in the art
- 7) the predictability of the art and
- 8) the breadth of the claims

The Board also stated that the level of skill in the pertinent art is high, the results of experimentation in treating a neoplasm in a mammal in need thereof are unpredictable. While all these factors are considered, a sufficient amount for a prima facie case are discussed below:

***The nature of the invention***

This invention relates to treatment of neoplasms.

***The amount of direction or guidance provided***

The amount of direction or guidance provided is insufficient in regard to a proper explanation as to how treatment directed toward neoplasms of any type. The instant specification discloses general extrapolations of the subject matter of claimed invention. Quantitative direction and/or guidance is lacking in view of the scope and variable susceptibilities of claimed invention.

***The quantity of experimentation necessary and state of the art***

The quantity of experimentation necessary is high. Further studies, research and development are required due to insufficient evidence in the instant specification to support a proper scope of enablement of current invention. The instant specification discloses no such examples of experimentation. The experimentation yields no quantifiable evidence (comparative data of disclosure of studies on various etiologies of neoplasms or neoplasm types via due experimentation).

***The presence or absence of working example***

A practicing working example disclosing an embodiment of the central issue of invention directed toward a method of treating any neoplasm type is absent.

One of ordinary skill in the pertinent art would not be readily inclined to reasonably envision the scope of enablement in view of the two examples disclosed within the instant specification.

***The predictability in the art***

The level of unpredictability is high in the art. The instant specification does not support the due experimentation necessary for the embodiments of claimed invention to be predictable.

For example, the term neoplasm/solid tumor encompasses three distinctly different categories of tumors: (1) sarcomas, those that arise from connective or supporting tissues, such as bone or muscle; (2) carcinomas, those that arise from glandular tissues and epithelial cells; and (3) lymphomas, those that arise from the lymphoid organs, such as the lymph nodes, spleen or thymus. There are distinct etiologies and pathophysiological differences between these three categories of solid tumor would not have imbued the skilled artisan with a reasonable expectation of success in treating any one or more of these neoplasm types.

The pertinent art still deems neoplastic conditions/solid tumors as unpredictable in their clinical behavior (Giuseppe et al., Pulmonary Epithelial-Myoepithelial Tumor of Unproven Malignant Potential: Report of a case and Review of the Literature, Mod

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Pathol (2001), 14(5): 521-526, printed pages 1-8, especially page 2, immediate paragraph under Full Table).

***Claim Rejection- 35 USC §102(e)***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The applied reference has a common inventor with the instant application.

Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention “by another,” or by an appropriate showing under 37 CFR 1.131.

Claims 1- 41 and 45-48 are rejected under 35 U.S.C. 102(e) as being anticipated by Dukart et al. (USPGPUB 2003/0008923 A1).

Dukart et al. teach neoplasms generally or four specific neoplastic conditions, i.e., colon, neuroblastoma, glioblastoma, rhabdomyosarcoma [0009], [0010], [0057].



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Dukart et al. teach CCI-779 [0006,0007].

Dukart et al. teach 42-O- (2-hydroxy) ethyl rapamycin ([0032,0034], (referenced claims 30 and 34)).

Dukart et al. teach letrozole [0064].

Dukart et al. teach a practicing method of administering subtherapeutically effective amounts (page 7, patented claim 27).

Dukart et al. teach neoplasms generally or four specific neoplastic conditions, i.e., colon, neuroblastoma, glioblastoma, rhabdomyosarcoma [0009], [0010], [0057].

Dukart et al. also teach renal cancer, soft tissue sarcoma, breast cancer, neuroendocrine tumor of the lung, cervical cancer, uterine cancer, head and neck cancer, glioma, non-small cell lung cancer, prostate cancer, pancreatic cancer, lymphoma, melanoma, small cell lung cancer, ovarian cancer, colon cancer, esophageal cancer, gastric cancer, leukemia, colorectal cancer, and unknown primary cancer (page 7, patented claims 1-22).

Dukart et al. teach variable pharmaceutical combinations and combination/formulation therapy (Abstract, [0012], [0058]).

Dukart et al. teach compositions and products which fully anticipate the subject matter of claimed invention. As shown above, Dukart et al. teach the exact therapeutic agents as disclosed in claimed invention.

Thus, Dukart et al fully anticipates the central issue of claimed invention.

The claim is anticipated by the reference. No question of obviousness is present. In other words, for anticipation under 35 USC 102, the reference must teach every

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aspect of the claimed invention either explicitly or impliedly. Any feature not directly taught must be inherently present.

***Claim Rejection- 35 USC §103(a)***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 42-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dukart et al. (USPGPUB 2003/0008923) in view of Bertelsen et al. (WO/2001/074335).

Dukart et al. teaches subject matter as applied above.

Bertelsen et al. teach novel pharmaceutical kit comprising controlled release pharmaceutical compositions for oral use containing midodrine and/or its active metabolite desglymidodrine and a relatively fast onset composition. The controlled release compositions are designed to release midodrine and/or desglymidodrine after oral intake in a manner which enables absorption to take place in the gastrointestinal tract so that a relatively fast peak plasma concentration of the active metabolite desglymidodrine is obtained followed by a prolonged and relatively constant plasma concentration of desglymidodrine. Also disclosed is a method for treated orthostatic hypotention and/or urinary incontinence, the method comprising administration to a patient in need thereof of an effective amount of midodrine and/or desglymidodrine in a kit according to the invention.

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Thus, it would be prima facie obvious to one of ordinary skill in the art of pharmaceuticals to at once recognize the reasonable expectation of success if the subject matter of Bertelsen et al was incorporated with the subject matter of Dukart et al. Dukart et al. teach every element of claimed invention with the exception of a pharmaceutical system or kit. Thus, the invention of Bertelsen et al. would be the motivation to combine due to the facilitation of administration and compliance via the use of any pharmaceutical kit, which requires the patient to adhere to a regimen of poly-pharmacy.

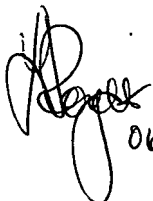

### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Timothy E. Betton whose telephone number is (571) 272-9922. The examiner can normally be reached on Monday-Friday 8:30a - 5:00p. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ardin H. Marschel can be reached on (571) 272-0718. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

TEB

  
06 AUG 07  
ARDIN H. MARSCHEL  
SUPERVISORY PATENT EXAMINER